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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,668	08/26/2003	Patrick M. Mulhern	P-1571	3921

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W. PATRICK QUAST
164 FRANKLIN TURNPIKE
WALDWICK, NJ 07463

EXAMINER

HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/648,668

Applicant(s)

MULHERN

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 7-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5 and 6 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6, drawn to a mold, classified in class 249, subclass 157.

II. Claims 7-12, drawn to a method for forming a snowman, classified in class 264, subclass 297.4.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions Group II and Group I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. MPEP § 806.05(e). In this case the apparatus as claimed can be used to practice another and materially different process such as wherein the mold is only used once, rather than in a repeated manner. Moreover, the mold could be used with materials other than snow.

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3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with W. Patrick Quast (Applicant's Representative) on January 26, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-6. Affirmation of this election must be made by Applicant in replying to this Office action. Claims 7-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Truman (U.S. Pat. No. 993,914).

Initially it is noted that the "means for engaging" language of claim 1 has been interpreted as invoking the

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provisions of 35 U.S.C. 112, sixth paragraph. That is, this limitation has been interpreted as limited to the corresponding structure described in the specification and equivalents thereof. In re Donaldson, 16 F.3d 1189, 1194, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994); MPEP § 2181. In this case, the disclosure of the instant application describes the means for engaging as a tab and slot structure as shown in Figures 1 and 2 and the corresponding description in the specification.

Truman discloses a molding apparatus in the form of a cake pan. The apparatus comprises a rectangular shaped flat sheet (2) having a first end (3) a second end (4), a top edge and bottom edge (see Figures 2 and 6). A means for engaging the first end a spaced distance from the second end is provided in the form of a tab (8) affixed to the first end and a slot (9) positioned a spaced distance away from the second end. Truman further provides a plurality of slots (9) being positioned at different areas denoting different circle diameters at spaced distances from the second end of the sheet (see p. 1, ll. 91-100).

It is noted that the claims recite a specific use for the claimed mold in that the mold is to be used with snow. It is well settled that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. In re

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Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (CCPA 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963); MPEP § 2115. In the instant case, as Truman discloses an apparatus with all of the structural features of the claimed mold, it anticipates the claim.

7. Claims 1, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Breidenstein et al. (U.S. Pat. No. 5,658,597).

Breidenstein discloses a kit which includes a molding structure (14). The molding structure comprises a rectangular shaped flat sheet of flexible material with a first end, a second end, a top edge, and a bottom edge (see Figure 1). Breidenstein discloses that the mold can be made from plastic (cl. 2, ll. 48-52), and thus an elastomeric material which could be rolled up.

Breidenstien further discloses a means for engaging the first end and second end of the mold sheet together for forming a circular shaped sheet in the form of notches (15 and 16). As noted above in the rejection in view of Truman, the means for engaging recited in claim 1 has been interpreted as invoking 35 U.S.C. § 112, sixth paragraph. However, the structure disclosed by Breidenstein is an equivalent because the notches disclosed

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by Breidenstein perform the function specified in the claim (connecting the ends of the mold sheet together) in substantially the same manner as the function is performed by the corresponding element described in the specification. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); MPEP § 2183.

8. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest a mold with the combination of features recited in claim 4. The closest prior art disclosed by Truman and Breidenstein is described above. Neither of these references teaches or suggests a plurality of tabs and a plurality of slots as defined in claim 4. Moreover there is no suggestion or reason in the prior art for such a modification of the references to comprise such features.

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10. The following reference cited but not relied upon is deemed pertinent to the instant application:

Harvey (U.S. Pat. No. 6,176,464) discloses a prior art snowman mold.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin Utech, can be reached at (571) 272-1137. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions

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on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at (866) 217-9197 (toll-free).

 2-7-05
~~Donald Heckenberg~~
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